

## **Remarks**

In response to the final Office Action mailed June 26, 2008, and having a period for response set to expire on September 26, 2008, Applicants respectfully request that the Examiner amend the present application in the manner set forth in this Amendment.

Claims 1, 2, 5 and 8-26 were pending in the application, and were rejected. By this paper, Applicants amend claims 1, 5, 13, 14, 17 and 22. Furthermore, claims 8, 10-12, 18-20 and 23-25 have been cancelled. No new matter has been introduced by this amendment. Applicants respectfully request reconsideration of the pending claims in view of the amendments contained herein and the following remarks.

### **Double Patenting Rejection**

Claims 1, 2, 5 and 8-26 stand rejected on the ground of non-statutory obviousness-type double patenting (ODP) as being unpatentable over claims 1-51 of U.S. Patent No. 6,488,203 (the '203 patent) in view of U.S. Patent No. 6,771,766 to Shafiee *et al.* (hereinafter "Shafiee"). As previously mentioned, claims 8, 10-12, 18-20 and 23-25 have been cancelled by this amendment. With respect to the remaining claims, Applicants respectfully traverse this rejection because the claims of the '203 patent, in combination with *Shafiee*, do not teach or suggest the pending claims.

Initially it is noted that the Office has failed to meet its burden in establishing a *prima facie* case of non-statutory ODP. The analysis employed in an ODP rejection, if not based on an anticipation rationale, parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. MPEP §804. In this regard, the *Graham* factual inquiries must be applied in establishing a basis for the obviousness determination. *Id.* The Office Action provides no indication that a *Graham* analysis was performed. Rather, the Office Action merely states that "[c]laims 1, 2, 5 and 8-26 essentially repeat all the features listed in the ['203 patent]" and recites a few exemplary features from the '203 patent. (Office Action, p. 3.) Notably, several of the

features recited from the claims of the '203 patent as the perceived basis for this rejection are missing in the claims of the present application, and vice versa. For example, contrary to the Office's contention, the claims of the '203 patent fail to recite "receiving the code information at the host computer from a dispensing terminal" and "allowing funds to be transferred by the dispensing terminal if the code is verified" as the Office Action incorrectly states. (See Office Action, p. 3.) Instead, the claims of the '203 patent are directed to a money transfer *send* transaction. Thus, they fail to even recite a dispensing terminal much less verifying a code at the dispensing terminal prior to dispensing funds, as the Office Action suggests. Note that "[w]hen considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art." MPEP §804.

Moreover, since the rationale for establishing a non-statutory ODP rejection parallels that of an obviousness determination under §103, the proposed combination of the '203 patent claims and *Shafiee* must teach or suggest *each and every feature* of the pending claims. Furthermore, this rationale must be properly articulated in order to sufficiently support a *prima facie* case. Failure to do so is fatal to the Office's rejection. To this end, the Office Action merely provides conclusory statements that all the features of the pending claims are disclosed in the cited references. The Office Action fails to even address several of the expressly recited features of the claims and/or identify where in the cited references an alleged teaching is to be found. Thus, the Office's non-statutory ODP rejection cannot be maintained for at least this reason.

Notwithstanding, it should be noted that the proposed combination of the claims of the '203 patent and *Shafiee* fails to teach or suggest each and every feature of the pending claims. For example, claims 1 and 14 of the present application each recite "providing a manned kiosk including a kiosk agent, ... receiving the unique personal identification number and the security code at the manned kiosk from the recipient, ... and dispensing funds corresponding to the designation of an amount of funds at the manned kiosk by the kiosk agent if the unique personal identification number and the security code provided by the recipient match the stored unique personal identification number and the stored security code." Similarly, independent

claim 5 recites "a manned kiosk in communication with the central terminal, the manned kiosk including an agent for receiving the unique personal identification number and the security code from the recipient." Claim 5 also recites that "the manned kiosk is operative to dispense funds corresponding to the designation of an amount of funds directly to the recipient when the unique personal identification number and the security code provided by the recipient match the stored unique personal identification number and the stored security code."

By contrast, none of the claims of the '203 patent recite use of a manned kiosk, as well as use of both a unique personal identification number and security code. Furthermore, *Shafiee* does not disclose use of a manned kiosk that performs the above claimed functions. Instead, *Shafiee* discloses "[e]stablishing a conference between a customer at a customer terminal and a live agent at an agent station." (Abstract.) In that regard, *Shafiee* discloses a system that "may include one or more customer terminals 110, one or more (web) site servers 120, one or more agent stations 130, one or more kiosks 140 and a multimedia call center server 150" that may each "communicate with one another via a network 170, such as the Internet for example." (Col. 4, ll. 57-63, and Fig. 1.) Thus, *Shafiee* does not teach use of a manned kiosk that performs the functions recited above, but rather an agent at an agent station that communicates with a remote customer terminal or kiosk.

For at least the above reasons, the double patenting rejection of the pending claims is believed to be improper and should be withdrawn.

#### **Obviousness Rejection**

Claims 1, 2, 5 and 8-26 stand rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,650,604 to Marcous *et al.* (hereinafter "*Marcous*") in view of *Shafiee*.

Applicants respectfully believe that the Office's proposed combination is improper. In that regard, *Marcous* discloses "a system and method for fully automated electronic transfer of cash or cash equivalent between a sender and a recipient." (Abstract). Furthermore, *Marcous* discloses that "[t]he system and method of the present invention provides a completely

electronic funds transfer mechanism, thereby eliminating the third party sales agent(s) in the transfer process." (Col. 3, ll. 4-7.) Thus, significantly, *Marcous* teaches away from use of a live agent as disclosed in *Shafiee*. Therefore, the combination of references is believed to be improper.

Furthermore, even if *Shafiee* was properly combinable with *Marcous*, the resultant combination would still fall short of the invention claimed in any of claims 1, 5 and 14. In that regard, claims 1, 5, 14, 17 and 22 each recite use of "a manned kiosk" including an "agent." Furthermore, claims 1 and 14 each recite "dispensing [to the recipient] funds corresponding to the designation of an amount of funds at the manned kiosk by the kiosk agent if the unique personal identification number and the security code provided by the recipient match the stored unique personal identification number and the stored security code." Similarly, claim 5 recites that "the manned kiosk is operative to dispense funds corresponding to the designation of an amount of funds directly to the recipient when the unique personal identification number and the security code provided by the recipient match the stored unique personal identification number and the stored security code."

As noted by the Office, *Marcous* "fails to teach the use of a manned kiosk." Contrary to the Office's assertion, *Shafiee* also fails to disclose use of a manned kiosk that performs the above functions. Instead, as noted above, *Shafiee* discloses "[e]stablishing a conference between a customer at a customer terminal and a live agent at an agent station." (Abstract.) In that regard, *Shafiee* discloses a system that "may include one or more customer terminals 110, one or more (web) site servers 120, one or more agent stations 130, one or more kiosks 140 and a multimedia call center server 150" that may each "communicate with one another via a network 170, such as the Internet for example." (Col. 4, ll. 57-63, and Fig. 1.) Thus, *Shafiee* does not teach use of a manned kiosk that performs the functions recited above, but rather an agent at an agent station that communicates with a *remote customer terminal* or kiosk.

Moreover, claims 1 and 14 each recite "wherein the security code comprises an image." Likewise, claims 17 and 22 recite "a security code comprising an image." Similarly,

claim 5 recites the feature of "wherein the security code comprises an image and the initiating terminal includes a scanning device for scanning the image." The proposed combination of *Marcous* and *Shafiee* fails to teach or suggest this aforementioned feature. The Office insists that using an image as a security code is obvious since "businesses have resorted to many different techniques of obtaining user security code for authentication purposes such as biometrics, voice recognition, iris print or fingerprints." (Office Action, p. 7.) However, the claims cannot be analyzed in a vacuum. Contrary to the Office's suggestion, biometrics, voice recognition, iris prints, fingerprints, or the like, are not suitable security codes for making electronic money transfer transactions. In that regard, a recipient cannot make use of a sender's security code to initiate the receive transaction since the sender would have to be present during the receive transaction. This would defeat the whole purpose of making an electronic money transfer. Instead, an image may be used so that the security code can be passed from the sender to the recipient.

Moreover, *Marcous* merely discloses that traditionally a sender of funds is requested at the initiating terminal for a security code such as a phone number, a social security number or other fanciful choice of the sender. (Col. 5, ll. 25-28.) From this information and other information, a transaction PIN is generated by the money transfer system and communicated to the sender. At the receiving end of the transaction, an intended recipient of the funds must provide the security code of the sender and the transaction PIN which the sender has communicated to the recipient.

The security code contemplated by *Marcous* was merely a number. Numbers, however, provide limited security of the transaction. Increasing the number of figures in the known security code number could enhance the security of the transaction, but it would become highly impractical for a sender and a recipient if the security code were to contain a long string of figures, since they must be entered into the transaction system at the initiating and dispensing terminals thereof.

The claims of the present application are directed to providing a method and system to enhance the security of the transaction without unduly burdening the sender or

recipient. In that regard, claims 1, 5, 14, 17 and 22 each recite that the "security code" comprises "an image," which may be scanned both at the initiating terminal and the manned kiosk to enable the authentication of the transaction in an easy, yet secure way, taking into account the large amount of information that an image may carry.

For at least the above reasons, the § 103(a) rejection is believed to be improper. Furthermore, independent claims 1, 5, 14, 17 and 22, as well as the associated dependent claims, are believed to be allowable. The dependent claims are believed to be allowable for at least the same reasons as their respective base claims, and further due to the additional features they recite. Separate and individual consideration of the dependent claims is respectfully requested.

**CONCLUSION**

Applicants submit that this Amendment After Final Rejection at least places this application in better form for appeal. Applicants respectfully submit that this Amendment should only require a cursory review because the claim amendments presented herein do not add any new features and/or do not significantly alter the scope of the claims. Consequently, the claim amendments should not require any further search by the Examiner. This Amendment is necessary as it clarifies and/or narrows the issues for consideration by the Board and was not earlier presented because Applicants believed that the prior responses placed this application in condition for allowance, for at least the reasons set forth in those responses. Accordingly, entry of the present Amendment, as an earnest attempt to advance prosecution and/or to reduce the number of issues, is requested under 37 C.F.R. §1.116.

In the event that the Office declines to enter the present Amendment, and (i) any portion of the present Amendment would place some of the claims in better form for appeal if a separate paper were filed containing only such amendments or (ii) any proposed amendment to any claim would render that claim allowable, Applicant respectfully requests that the Office inform Applicant of the same pursuant to MPEP §714.13.

Applicants have made a genuine effort to respond to each of the Examiner's rejections in advancing the prosecution of this case. Applicants believe that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If any additional issues need to be resolved, the Examiner is invited to contact the undersigned at his earliest convenience.

The Commissioner is hereby authorized to charge any additional required fees or credit any overpayments to our Deposit Account No. 02-3978.

Respectfully submitted,  
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Date: August 26, 2008

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